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51

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,601	01/20/2000	Evgeniy M. Getsin	IACTP016	6034

22242 7590 07/09/2004

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CHICAGO, IL 60603-3406

EXAMINER

SHELTON, BRIAN K

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 07/09/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/489,601

Applicant(s)

GETSIN ET AL.

Examiner

Brian Shelton

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12-15</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. This Action is in response to Applicants' Amendment filed 30 April 2004 (hereinafter "Amendment").

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson, U.S. Patent No. 5,825,876 (of record) in view of Kinney et al. (Kinney), U.S. Patent No. 5,808,662 (provided by Applicants in the IDS filed 19 March 2004).

Regarding **claims 1, 6 and 11**, Peterson discloses a method, corresponding computer program and corresponding system for identifying a plurality of events which are played back on a plurality of networked client apparatuses (col. 2, lines 26-41), comprising

- (a) providing a plurality of events stored in memory (medium **10**) on a plurality of client apparatuses (controller **14**; see col. 2, lines 46-54 disclosing system methodology including multiple consumers,

comprising multiple events and client apparatuses), the events each having a unique identifier associated therewith and stored in memory (identifier **24**; see col. 5, lines 30-35), wherein the client apparatuses are adapted to be coupled to a host computer (authorization center **16**) via a network (PTSN **18**; see col. 8, lines 13-16);

- (b) ascertaining the identifier of the event stored in memory of the client apparatuses utilizing the network (col. 8, lines 18-27, disclosing transmission of identifier **24** to server **60** and return of authorization granted message comprising identifier **24** of secured content **28**);
- (c) comparing the identifier with an identifier of a scheduled event (col. 8, lines 23-26; col. 8, lines 41-47 describing the scheduled (premier) event time and date; see col. 8, line 66 - col. 9, line 5 describing comparison of content **28** associated with identifier **24** to authorization list **56**); and
- (d) beginning playback of the event on each of the client apparatuses if the comparison renders a match (col. 9, lines 18-21; see col. 2, lines 54-58, disclosing playback on or after premier event time).

Although Peterson discloses the period for playback beginning simultaneously (e.g., common premier time), Peterson fails to specifically disclose beginning playback of the event simultaneously.

However, Kinney, in an analogous art, teaches simultaneously beginning the playback of a movie (Fig. 1, col. 3, lines 9-15; see col. 3, lines 42-65, describing locally stored movie on client terminals; see also col. 5, lines 36-64, describing transmission of playback function to each client apparatus) for the benefit of providing collaborative, interactive viewing of movies by multiple participants in remote locations (see col. 2, lines 26-30).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the playback of Peterson to incorporate beginning the playback of the event simultaneously, as taught by Kinney, for the benefit of providing collaborative, interactive viewing of movies by multiple participants in remote locations.

**Claims 2, 7, and 12** are encompassed by the teachings of Peterson in view of Kinney (as discussed above). Specifically, Peterson discloses the event including a video and audio presentation (col. 2, lines 46-50).

**Claims 3, 8, and 13** are encompassed by the teachings of Peterson in view of Kinney (as discussed above). Specifically, Peterson discloses the event including a movie (col. 2, lines 46-50).

**Claims 4, 9, and 14** are encompassed by the teachings of Peterson in view of Kinney (as discussed above). Specifically, Peterson discloses a wide area network (PTSN 18, col. 8, lines 12-17).

**Claims 5, 10, and 15** are encompassed by the teachings of Peterson in view of Kinney (as discussed above). Specifically, Peterson discloses the memory including a digital video disk (col. 5, lines 24-27).

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

5. Applicants' arguments concerning the alleged teaching away of the Peterson reference and the subsequent lack of motivation to modify Peterson (see Amendment at pages 7-8) have been considered and deemed unconvincing. In support of this teaching away allegation, Applicants' place significant emphasis on the revenue generating purpose of Peterson (Amendment at pages 7-8). Applicants seize upon this revenue generating function in an attempt to demonstrate that modification of Peterson to incorporate simultaneous playback would constitute a destruction of purpose, stating "[Peterson's] system would be greatly devalued...if a consumer could only view the movie simultaneously with many other users." (Amendment at page 8).

However, analysis of the Peterson reference reveals nothing to support Applicants' unsubstantiated contention that the system disclosed by Peterson could not

be modified to incorporate additional features. To the contrary, the combination of Peterson in view of Kinney demonstrates modification of Peterson's playback system to incorporate the element of simultaneously beginning playback for the benefit of providing collaborative, interactive viewing of movies by multiple participants in remote locations (see discussion above in rejection of claims 1, 6, and 11). Thus, by adding the feature of simultaneously beginning playback, as taught by Kinney, the revenue generating function would very likely be enhanced, not devalued as Applicants suggest.

Moreover, contrary to Applicants' assertion, there is no reason to believe that consumers would be restricted to *only* viewing movies simultaneously. (Amendment at page 8). As demonstrated above, the combination of Peterson in view of Kinney discloses incorporating the feature of simultaneous playback. However, Applicants fail to explain why incorporating a simultaneous playback feature would prevent the system disclosed by Peterson from operating as originally disclosed in coexisting embodiments.

Accordingly, Applicants' arguments regarding teaching away of the Peterson reference are found unpersuasive and the claims are therefore rejected under 35 U.S.C. 103, as discussed above.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 2611

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### **Certificate of Mailing**

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Alexandria, VA 22313-1450

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Shelton whose telephone number is (703) 305-8714. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the primary examiner, Christopher Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian Shelton  
Examiner  
Art Unit 2611

BS

  
CHRIS GRANT  
PRIMARY EXAMINER